Supreme Court, U.S.
FILED
MAR 12 1997
OFFICE OF THE CLERK

(3)

No. 95-1096

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

MICRON SEPARATIONS, INC.,
Petitioner,

v.

PALL CORPORATION,
Respondent.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

SECOND SUPPLEMENTAL BRIEF IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI

STEVEN M. BAUER
Counsel of Record
JOHN J. COTTER
TESTA, HURWITZ
& THIBEAULT, LLP
125 High Street
Boston, MA 02110
(617) 248-7000
Attorneys for Petitioner,
Micron Separations, Inc.

8 pp

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES.....ii

CERTIORARI SHOULD BE GRANTED TO REVIEW THIS CASE IN VIEW OF THE RECENT DECISION IN THE *HILTON DAVIS* CASE (NO. 95-728).....2

CONCLUSION.....5

TABLE OF AUTHORITIES

Cases Page

Hilton Davis Chem. Co. v. Warner-Jenkinson Co., 62 F.3d 1512 (Fed. Cir. 1995) (*en banc*) 2,3

Warner-Jenkinson Co. v. Hilton Davis Chem. Co., No. 95-728, 1997 WL 84999 (U.S. Mar. 3, 1997) 1,2,3,4

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

MICRON SEPARATIONS, INC.,
Petitioner,

v.

PALL CORPORATION,
Respondent.

SECOND SUPPLEMENTAL BRIEF OF PETITIONER IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI

Petitioner Micron Separations, Inc. ("MSI") respectfully submits this Second Supplemental Brief in support of its petition for certiorari to provide this Court with new information not in existence at the time MSI filed its initial brief and its first supplemental brief. MSI believes it is important for this Court to consider its recent decision issued in a case presenting nearly identical factual and legal issues, namely *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, No. 95-728, 1997 WL 84999 (U.S. Mar. 3, 1997), while considering MSI's petition for certiorari.

CERTIORARI SHOULD BE GRANTED TO REVIEW THIS CASE IN VIEW OF THE RECENT DECISION IN THE *HILTON DAVIS* CASE (NO. 95-728)

On March 3, 1997, this Court decided *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, No. 95-728, 1997 WL 84999 (U.S. Mar. 3, 1997) to review the same fundamental question of patent law as that posed in MSI's petition for certiorari. In *Hilton Davis*, this Court considered how broadly a patent claim may be construed under the doctrine of equivalents when the accused device or process clearly does not fall within the literal scope of the patent claim at issue.

As MSI pointed out previously, the MSI case and *Hilton Davis* present substantially identical legal and factual issues. The Federal Circuit's decision in the MSI case relies on its decision in *Hilton Davis*, 62 F.3d 1512 (Fed. Cir. 1995) (*en banc*). Pet. App. 11a. The MSI case and *Hilton Davis* involve strikingly similar facts. Each involves a patent on polymer membrane technology, and each involves claims directed to certain narrow ranges of properties. In both *Hilton Davis* and the MSI case, the Federal Circuit found no literal infringement, but found infringement under the doctrine of equivalents even though the accused processes and products were well below the claimed lower limit of the ranges of the respective patents. In *Hilton Davis*, the patentee narrowed its claims during the patent application process to require the use of a pH range of "from approximately 6.0 to 9.0." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, No. 95-728, 1997 WL 84999, at *4 (U.S. Mar. 3, 1997). In the MSI case, the patentee (Pall Corporation) narrowed its claims to require use of a nylon having a specific chemical ratio within a range of "about 5:1 to about 7:1." Pet. App. 12a-13a. In *Hilton Davis*, the

Federal Circuit held that a process with a pH of 5.0 infringed, even though the lower limit of the claim was "approximately 6.0." *Hilton Davis*, 62 F.3d at 1524. In the MSI case, the Federal Circuit held that a ratio of 4:1 infringed, even though the lower limit of the claim was "about 5:1." Pet. App. 16a.

In its initial brief, MSI noted that if this Court granted certiorari in *Hilton Davis*, it also should consider the MSI case, to see that the issues raised in *Hilton Davis* have widespread applicability in patent cases. Now that certiorari has been granted and a decision has been issued in *Hilton Davis*, this Court should grant certiorari here in view of the similarity of the cases. As in *Hilton Davis*, this Court should remand MSI's case to the Federal Circuit with directions to consider MSI's case in view of the prosecution history estoppel requirements set forth in *Hilton Davis*.

In *Hilton Davis*, this Court's prosecution history estoppel ruling focused on probing for "the reasoning behind the Patent Office's insistence upon a change in the claims." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, No. 95-728, 1997 WL 84999, at *9 (U.S. Mar. 3, 1997). The Court placed the burden on the patentee to establish the reason for addition of a patent claim element:

> we think the better rule is to place the burden on the patent holder to establish the reason for an amendment required during patent prosecution. The court would then decide whether the reason is sufficient to overcome prosecution history estoppel as a bar to application of the doctrine of equivalents to the element added by amendment. Where no explanation is established, however, the

> court should presume that the PTO had a substantial reason related to patentability for including the limiting element added by amendment. In those circumstances, prosecution history estoppel would bar the application of the doctrine [of] equivalents as to that element.

Warner-Jenkinson Co. v. Hilton Davis Chem. Co., No. 95-728, 1997 WL 84999, at *10 (U.S. Mar. 3, 1997).

This Court remanded the *Hilton Davis* case even though the Federal Circuit found that prosecution history estoppel did not preclude application of the doctrine of equivalents, in view of the Federal Circuit's failure to allocate to the patentee the burden on estoppel. *Id.* Similarly, in the MSI case, the district court and the Federal Circuit did not specifically allocate to Pall the burden of proving the reason for the change in the claims. *See* Pet. App. 16a, 92a. Because the proper allocation of that burden is critical to this Court's standard for evaluating prosecution history estoppel, it is appropriate to grant certiorari here, and remand the case for consideration of that burden.[1]

---

[1] Respondent Pall, in its Opposition Brief, claimed there were no legal similarities between the *Hilton Davis* and MSI cases, and tried to distinguish this case from *Hilton Davis* based on factual issues involved at the Patent and Trademark Office, claiming that MSI did not "contest" the doctrine of equivalents issue below and instead focused on prosecution history estoppel. While MSI's appeal to the Federal Circuit clearly raised the issue of whether a claim could be broadly construed beyond its literal scope, it is unnecessary for the Supreme Court to consider Pall's assertion of "differences" between *Hilton Davis* and this case, because it is for the Federal Circuit or district court on remand to address Pall's assertion. Furthermore, now that this Court has issued its *Hilton Davis* opinion which establishes the standard for reviewing prosecution history estoppel and the

CONCLUSION

MSI's Petition for a Writ of Certiorari should be granted.

Dated: March 11, 1997

Respectfully submitted,

STEVEN M. BAUER
Counsel of Record
JOHN J. COTTER
TESTA, HURWITZ
& THIBEAULT, LLP
125 High Street
Boston, MA 02110
(617) 248-7000

Attorneys for Petitioner,
Micron Separations, Inc.

---

relationship of prosecution history estoppel to the doctrine of equivalents, Pall cannot complain that MSI's case is not impacted directly by *Hilton Davis*.